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In re Application of  
Dehou Fei et al  
Serial No.: 10/681,103  
Filed: October 9, 2003  
Attorney Docket No.:

PETITION DECISION

This is in response to the petition under 37 CFR 1.144, filed August 6, 2007, requesting withdrawal of an improper restriction requirement.

BACKGROUND

A review of the file history shows that this application was filed under 35 U.S.C. 111 on September 29, 2004, and contained claims 1-4. Subsequent to acceptance of the application a petition to make the application special in view of the age of at least one of the inventors was filed and granted on March 30, 2005. Shortly thereafter in a first Office action, mailed June 21, 2005, the examiner assigned to the application required restriction between the inventions claimed by setting forth 4 groups of invention, as follows:

- Group I, claim 1, drawn to a liquid additive and supplementary health pill;
- Group II, claim 2, drawn to a method of reducing toxicity by applying a liquid additive to tobacco;
- Group III, claim 3, drawn to preventing diseases utilizing a health pill; and
- Group IV, claim 4, drawn to eliminating addiction safely and effectively.

The examiner expressed a number of reasons for requiring restriction including distinctness of each invention from the other and burden on the Office to examine all inventions in the same application. (That is to say that the inventions, while somewhat related to each other, would require different searches, search techniques and patentability considerations.)

Following a telephonic interview on or about July 8, 2005, applicants replied on July 11, 2005, electing Group III and presenting a new claim 5 which was in reality five new claims under a heading of "Claim 5". Applicants did not specifically or formally traverse the restriction requirement at this time.

A Notice of Non-Compliant Amendment was mailed to applicants on August 2, 2005, to which reply was made on August 24, 2005. A second Notice of Non-Compliant amendment was mailed to applicants on August 31, 2005, but was eventually withdrawn on March 29, 2007; and a miscellaneous letter sent to applicants to show how the claims should be properly written. Applicants then submitted an acceptable amendment on April 20, 2007.

The examiner mailed a new Office action to applicants on June 15, 2007. In view of applicants' election of claim 3 of the original claims, which was now canceled, the examiner considered claims 5-6 which correspond to original claim 3 as the elected claims. The examiner again explained the reasons for restriction in detail and made the requirement for restriction Final. The examiner then rejected claims 5 and 6 under 35 U.S.C. 112, first paragraph, for lack of written description in the specification, and under 35 U.S.C. 112, second paragraph, as indefinite, giving reasons therefore. The examiner also conducted extensive telephone interviews with applicants on May 31, and June 7, 2007, in preparation for issuing the Office action.

Subsequent to the mailing of the Office action the examiner conducted additional telephonic interviews with applicants on July 11, and August 1, 2007 to give applicants further guidance in prosecuting their application.

On August 6, 2007, applicants filed this petition consisting of 10 pages with 80 pages of attachments, mostly copies of application papers already on file.

## DISCUSSION

As noted, the petition is extensive and is directed to the propriety of the restriction requirement set forth by the examiner, but includes a great deal of material and argument which is not pertinent to the question of whether the requirement for restriction is proper. As applicants are prosecuting their own application some latitude with conformance to the rules of prosecution is permitted. However, it would be in applicants' best interests to employ the services of a patent attorney or agent to assist in the prosecution of this application and to minimize the delays occasioned by the Office mailing of Notices of Non-Compliance in the future.

A review of the restriction requirement set forth by the examiner with respect to claims 1-4 and now applied to claims 5-9, shows that it is proper and in accordance with the rules of prosecution of patent applications. Applicants' arguments have been considered carefully, however they are not persuasive of error on the examiner's part. A review of applicants two independent composition claims, currently claims 5 and 7 shows that the compositions have only one (of about ten) component in common, the cyclodextrin. Thus the compositions are two separate compositions of matter each of which may be separably patentable. Thus they are properly examined separately in two different applications since the Patent Statute (Law) strongly suggests and has been interpreted as limiting each patent to one invention. Further, the two method claims, current claims 8 and 9, are considered a different statutory class of invention from compositions and are properly restricted from applications claiming compositions. It is frequently the case that the invention of a novel compound or composition of matter also involves a novel (and separately patentable) method of making or method of using the compound or composition. Applicants even quote 35 U.S.C. 101 as part of their argument which states:

“Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor,” meaning that any new or useful process or machine or manufacture or composition of matter may be the subject of a (one) patent. That does not mean that a combination of these types of invention may all be the subject of the same patent.

For the above reasons the restriction requirement is considered proper and will not be withdrawn.

## DECISION

The petition is **DENIED** for the reasons set forth above.

**Applicants remain under obligation to reply to the Office action mailed June 15, 2007, within the time period set therein or as extended under 37 CFR 1.136(a). The filing of a petition is not considered a reply to the Office action.**

## ADDITIONAL COMMENTS

Applicants make a number of comments ancillary to the petition of the restriction requirement which it is thought should be addressed. For instance applicants appear to be of the belief that a telephone conversation with an unnamed Office employee shortly after the application was filed was an indication that the application would issue as a patent. What in all likelihood happened is that after filing the application applicants talked with an individual who indicated that the application had been received and had been initially reviewed for compliance with the applicable filing requirements and had met them and that the application was, therefore, ready for examination by a qualified examiner. No indication was given or should have been assumed that the application was ready to be issued as a patent. It is regretted that applicants misunderstood what was communicated to them at that time.

Applicants appear to believe that this application was at some time abandoned. No Notice of Abandonment was ever mailed to applicants, thus no abandonment of the application has ever taken place. Prosecution of this application, which was advanced out of turn due the granting of a petition to make special, has proceeded in a normal manner along with the prosecution of approximately 1,000,000 other pending applications. Unfortunately, due to the large number of active applications, prosecution within the Office is sometimes slowed by this and other factors. It is noted that the examiner of this application has tried to assist applicants as much as possible as evidenced by the numerous telephone interviews. In view of this, it is again urged that applicants strongly consider consultation with, or employment of, a registered patent attorney or agent in order to bring prosecution of this application to a conclusion.

Applicants also make allegations that the actions of this agency have or can be influenced by other agencies (such as Department of Justice). Nothing could be further from the truth. This agency administers the Patent Laws, Title 35 U.S.C., and the agency is independent of any other agency of the government. The Patent Laws set forth the specific criteria for granting of a patent and the agency issues more than 100,000 patents each year which meet these criteria. Applications which do not meet these criteria do not issue as patents. Nor can congressional

influence cause the issuance of a patent which does not meet these criteria. Employees of the Office must meet and maintain the highest ethical standards as do any attorneys or agents who desire to practice before the Office. Thus any allegations of wrong-doing or impropriety are without merit.

Should there be any questions about this decision please contact William R. Dixon, Jr., by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0519 or by facsimile sent to the general Office facsimile number, 571-273-8300.

  
Bruce M. Kisluk  
Director, Technology Center 1600